

Attorney Docket No. 5405-264

PATENT #7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Pericak-Vance et al.

Confirmation No.: 9656

Application No.: 10/520,695

International Filing Date: July 11, 2003

For: *GENETIC SUSCEPTIBILITY GENES FOR ASTHMA AND ATOPY AND ASTHMA-RELATED AND ATOPIC-RELATED PHENOTYPES*

Date: May 18, 2006

ATTENTION: Office of PCT Legal Administration

Mail Stop PCT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RESPONSE TO DECISION REGARDING REQUEST TO CORRECT INVENTORSHIP

Sir:

In response to the April 12, 2006 Decision issued in connection with the above-identified patent application, enclosed are:

- 1) a copy of the Notice of Recordation of Assignment Document for this application, identifying the reel and frame number where the Assignment for this application has been recorded, thereby establishing that Duke University is the assignee of this application; and
- 2) a copy of the Decision stating that all of the requirements of 37 CFR 1.497(d) are complete except for evidence of the assignment of this application to Duke University.

No fee is believed due. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No 50-0220.

Respectfully submitted,



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CERTIFICATE OF EXPRESS MAILING

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Date of Deposit: May 18, 2006

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Office of PCT Legal Administration, Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Tracy Wallace



12 APR 2006

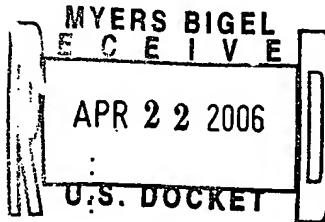
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In re Application of
PERICAK-VANCE et al
U.S. Application No.: 10/520,695
PCT No.: PCT/US03/21963
Int. Filing Date: 11 July 2003
Priority Date: 12 July 2003
Attorney's Docket No.: 5405.264
For: GENETIC SUSCEPTIBILITY GENES
FOR ASTHMA AND ATOPY AND
ASTHMA-RELATED AND ATOPIC-
RELATED PHENOTYPES



DECISION

This is a decision on the request to add two inventors and delete one inventor in the above-captioned application filed 14 November 2005. This is treated under 37 CFR 1.497(d).

BACKGROUND

04-17-06 A 3 : 17 PM

On 12 July 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 14 November 2005, applicant filed a response which was accompanied by, *inter alia*, a request to add and delete named inventors; a two-month extension request and fee; a surcharge fee; the processing fee; an executed declaration listing four inventors; statements from two inventors being added and one inventor being deleted; a consent of assignee statement; and authorization to charge any additional fees to Deposit Account No. 50-0220.

DISCUSSION

Applicants request to add Marcy C. Speer and Michael A. Hauser and remove Jonathan L. Haines as inventors in the above-captioned application. 37 CFR 1.497(d) applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application (see 37 CFR 1.48(f)(1)). 37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(l); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Applicants provided the requisite statements from the two inventors being added and one inventor being deleted that the error in inventorship was "inadvertent and occurred without any deceptive intent" on their part. The processing fee of \$130.00 was paid. Items (1) and (2) above, are satisfied.

Applicants also provided a consent of the assignee statement signed by Robert L. Tabor as Vice Chancellor of Duke University. The position of Vice Chancellor is an officer of the university and is presumed to have the apparent authority to sign on its behalf. See MPEP § 324.

However, applicants have not established that Duke University is the assignee of the subject application. Specifically, applicants did not provide a copy of the recorded assignment or state the location of the assignment, e.g. reel and frame number. See 37 CFR 3.73(b)(1). For this reason, item (3) is not yet satisfied.

Therefore, all the requirements of 37 CFR 1.497(d) are not complete.

CONCLUSION

For the reason discussed above, applicants' request under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia

10/520,695

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22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson

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Attorney Advisor
Office of PCT Legal Administration

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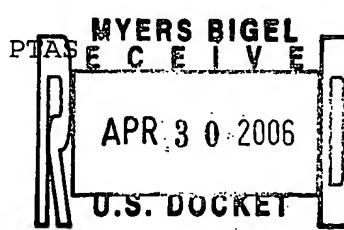
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

APRIL 17, 2006

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UNITED STATES PATENT AND TRADEMARK OFFICE NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

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RECORDATION DATE: 11/10/2005

REEL/FRAME: 017479/0175

NUMBER OF PAGES: 12

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).
DOCKET NUMBER: 5405-264

ASSIGNOR:

PERICAK-VANCE, MARGARET A.

DOC DATE: 10/19/2005

ASSIGNOR:

VANCE, JEFFERY M.

DOC DATE: 10/20/2005

ASSIGNOR:

SPEER, MARCY C.

DOC DATE: 10/31/2005

ASSIGNOR:

HAUSER, MICHAEL A.

DOC DATE: 11/04/2005

ASSIGNEE:

DUKE UNIVERSITY
ERWIN ROAD
CITY OF DURHAM
COUNTY OF DURHAM, NORTH CAROLINA

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017479/0175 PAGE 2

SERIAL NUMBER: 10520695

FILING DATE:

PATENT NUMBER:

ISSUE DATE:

TITLE: GENETIC SUSCEPTIBILITY GENES FOR ASTHMA AND ATOPY AND ASTHMA-RELATED AND ATOPIC-RELATED PHENOTYPES

VIOLET MCCOY, EXAMINER
ASSIGNMENT SERVICES BRANCH
PUBLIC RECORDS DIVISION

ASSIGNMENT RECORD

01-24-2006

Patents Only

To: Commissioner for Patents

103163335

Date: January 19, 2006
Attorney Docket No. 5405-264

Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

[1.] Margaret A. Pericak-Vance
 [2.] Jeffery M. Vance
 [3.] Marcy C. Speer
 [4.] Michael A. Hauser

Additional name(s) of conveying party(ies) attached? Yes No

3. Nature of conveyance:

Assignment
 Merger
 Security Agreement
 Change of Name

Other: Response to Notice of Non-Recordation of Document (Doc ID No. 700224058, issued January 12, 2006, copy enclosed)

Execution Date:

[1.] October 19, 2005 [2.] October 20, 2005 [3.] October 31, 2005 [4.] November 4, 2005

4. Application Serial No. 10/520,695Additional numbers attached? Yes No

5. Name and address of party to whom correspondence concerning document should be mailed:

Mary L. Miller
 Myers Bigel Sibley & Sajovec
 P. O. Box 37428
 Raleigh NC 27627

6. Total number of applications and patents involved: 17. Total fee (37 CFR 3.41) \$40.00 Enclosed

Authorized to be charged to deposit account if necessary, \$40.00 previously paid November 10, 2005

8. Deposit account number: 50-0220

DO NOT USE THIS SPACE

9. Statement and signature

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Mary L. Miller

Mary L. Miller-39,303

January 19, 2006

Date

Total number of pages including cover sheet, attachments and document: 15

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Date of Deposit: January 19, 2006

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Tracy Wallace

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